

The Office Action is silent as to which statutory section Hinckley applies as prior art. Hinckley was filed on September 14, 1998 (before the present application was filed) and issued on May 28, 2002 (after the present application was filed). Thus, since Hinckley issued after the present application was filed, Hinckley is inapplicable to be prior art in a 35 USC 102(a) or 102(b)-based 103 rejection. Since Hinckley was filed before the present application, Applicants have assumed that the Office Action is construing Hinckley to be prior art under a 35 USC 102(e) basis in the 35 USC 103 rejection.

Both Hinckley and the present application are assigned to Microsoft. Since the issue date of Hinckley is May 28, 2002 and the filing date of the instant application is October 31, 2000 (subsequent to November 29, 1999), all the provisions of 35 U.S.C. § 103(c) are effective. According to 35 U.S.C. § 103(c), subject matter developed by another which qualifies as prior art under 35 U.S.C. § 102(e), (f), and/or (g) “shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made . . . subject to an obligation of assignment to the same person” or entity.

Since both Hinckley and the instant application were commonly owned or subject to assignment to the same entity, i.e., Microsoft Corporation, at the time the invention was made, Hinckley cannot be used as prior art in any rejection of the instant application pursuant to 35 U.S.C. § 103.

Applicants’ argument that the rejection should be withdrawn because Hinckley is not statutory prior art for the 35 USC 103-based rejection does not constitute an admission relating to the scope of the documents relied upon in the rejection or to the rationale of the rejection.

Accordingly, applicants respectfully request withdrawal of the rejection of claims 1-32 based on Hinckley in combination with Katinecz.

***Conclusion***

With all pending rejections being rendered moot, Applicants respectfully submit that the instant application is in condition for allowance. If the Examiner feels, that further discussion may be helpful in facilitating prosecution of the case, the Examiner is respectfully requested to telephone the undersigned attorney of record at the telephone number appearing below.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Date: 9/5/82

By: 

1001 G Street N.W.  
11th Floor  
Washington, D.C. 20001  
(202) 508-9100

Robert S. Katz  
Registration No. 36,402